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10/650,912

08/28/2003

John J. Janik

8683

7590

11/13/2006

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EXAMINER

EBRAHIM, NABILA G

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/650,912 | Applicant(s) JANIK ET AL. | |
| | Examiner Nabila G. Ebrahim | Art Unit 1618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 3-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not have any support for the use of gelatin, glycerin, or water. While the specification describes a food product to be added to hot beverages, which is a capsule made of hydroxymethyl cellulose and contains honey, it fails to disclose any other compositions for the capsule in specific wherein the capsule is made of gelatin, glycerin, and water.

This is a new matter rejection.

In accordance with MPEP 714.02 applicants should specifically point out support for the disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claim 4 recites the limitation "wherein the capsule consists of beef gelatin" in line 2. There is insufficient antecedent basis for this limitation in the claim. Applicant is expected to recite: "Wherein the gelatin is beef gelatin".

3. Claim 5 recites the limitation "wherein the capsule consists of pork gelatin". There is insufficient antecedent basis for this limitation in the claim. Applicant is expected to recite: "Wherein the gelatin is beef gelatin".

4. Claim 6 recites the limitation "wherein the capsule consists of gelatin and water" in line 2. There is insufficient antecedent basis for this limitation in the claim. The claim depends from claim 3. Claim 3 recites "a capsule consisting of gelatin, glycerin and water". Applicant cannot omit glycerin while using "consisting of"

5. Claim 7 recites the limitation "wherein the capsule consists of beef gelatin" in line 2. There is insufficient antecedent basis for this limitation in the claim. The claim depends from claim 3. Claim 3 recites "a capsule consisting of gelatin, glycerin and water". Applicant cannot omit glycerin and water while using "consisting of". It is also advised that applicant describes gelatin as follows: "wherein the gelatin is beef gelatin"

6. Claim 8 recites the limitation "wherein the capsule consists of beef gelatin" in line 2. There is insufficient antecedent basis for this limitation in the claim. The claim depends from claim 3. Claim 3 recites "a capsule consisting of gelatin, glycerin and water". Applicant cannot omit glycerin and water while using "consists of". It is also advised that applicant describe gelatin as "wherein the gelatin is pork gelatin"

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7. Claim 10 recites the limitation "wherein the capsule consists of beef gelatin

glycerin and water" in line 2. There is insufficient antecedent basis for this limitation in

the claim. Applicant is expected to recite: "Wherein the gelatin is beef gelatin".

8. Claim 11 recites the limitation "wherein the capsule consists of pork gelatin glycerin

and water" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Applicant is expected to recite: "Wherein the gelatin is pork gelatin".

9. Claim 12 recites the limitation "wherein the capsule filled with honey consists of a

capsule of gelatin and water" in lines 1, and 2. There is insufficient antecedent basis for

this limitation in the claim. The claim depends from claim 9. Claim 9 recites "a capsule

consisting of gelatin, glycerin and water". Applicant cannot omit glycerin while using

"consists of"

10. Claim 13 recites the limitation "wherein the capsule filled with honey consists of a

capsule of beef gelatin" in lines 1, and 2. There is insufficient antecedent basis for this

limitation in the claim. The claim depends from claim 9. Claim 9 recites "a capsule

consisting of gelatin, glycerin and water". Applicant cannot omit glycerin and water while

using "consists of". In addition, Applicant is expected to recite: "Wherein the gelatin is

beef gelatin".

11. Claim 13 recites the limitation "wherein the capsule filled with honey consists of a

capsule of pork gelatin" in lines 1, and 2. There is insufficient antecedent basis for this

limitation in the claim. The claim depends from claim 9. Claim 9 recites "a capsule

consisting of gelatin, glycerin and water". Applicant cannot omit glycerin and water while

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using "consisting of". In addition, Applicant is expected to recite: "Wherein the gelatin is pork gelatin".

12. Claim 16 provides for the use of the food product as a dietary supplement, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Opheim US 6,652,879 (Opheim) in view of Fischer US 4,804,542 (Fischer.)

Opheim teaches A flavored gelatin capsule and the method of manufacture of the flavored capsule is provided. The capsule may comprise (a) from about 10 to about 70 parts by weight of gelatin; (b) from about 10 to about 35 parts by weight of a suitable polyol, such as glycerol; (c) from about 8 parts by weight of water; and (c) various parts by weight of particular water-soluble flavorings (abstract.)

Opheim did not disclose filling the gelatin capsule with honey.

Fischer discloses gelatin capsules, consisting of a capsule sheath and a capsule filling (abstract). The capsule is filled with one or more materials selected from a group, which includes honey (claim 4 and example 8).

Accordingly, it would have been obvious to one of ordinary skills in the art to use the capsule disclosed by Opheim which is made of gelatin, glycerol, and water and fill it with honey as disclosed by Fischer. The motive would be the disclosure of Fischer that it has been possible according to his invention to prepare capsule fillings containing one or more materials selected from the group comprising concentrated aqueous sugar solutions, starch syrups, hydrogenated starch syrups, sugar derivative solutions and honey. In addition, the skilled artisan would have preferred honey because it is used a sugar substitute as known in the art (See: Strubig W, Gulzow HJ. (Dried fruit as sugar

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substitute?) Oralprophylaxe. 1989 Sep;11(3):90-4). The expected result would be a capsule made of gelatin, glycerol, and water and filled with honey.

Double Patenting

13. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Claims 1, and 2 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, and 2 of prior U.S. Patent No. 6, 610337. This is a double patenting rejection.

Conclusion

No Claims are allowed at this time.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabila G. Ebrahim whose telephone number is 571-272-8151. The examiner can normally be reached on 8:00AM-5:00PM.

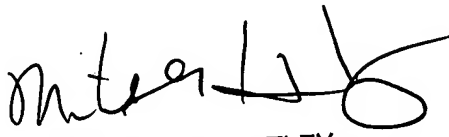
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nabila Ebrahim

11/2/06



MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER